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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,262	07/25/2003	Hakan P.O. Larsson	03370-P0047A	7595

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EXAMINER

WILLIAMS, THOMAS J

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,262

Applicant(s)

LARSSON ET AL.

Examiner

Thomas V. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Acknowledgment is made in the receipt of the amendment filed September 3, 2004.
2. The drawings were received on September 3, 2004. These drawings are approved.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 6 recites the limitation "the end" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The phrase "the end" should be changed to "an open end".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/37010 to Kapaan et al.

Re-claim 1, Kapaan et al. discloses a modular disc brake, comprising : a service brake mechanism 2 and modules in the form of a frame 1, a house 63 for the service brake mechanism and a cover 5, the frame 1 has a recess to receive the house 63.

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Re-claim 2, the house does not take up any load during braking.

Re-claim 4, the brake mechanism is a single pre-mounted unit received in the house (see also figures 3 and 4).

Re-claim 12, elements 72 are interpreted as pull rods that clamp the cover to the frame without passing through the house.

Re-claim 14, Kapaan et al. discloses a modular disc brake, comprising : a brake mechanism 2 and modules in the form of a frame 1, a house 63 for the brake mechanism and a cover the frame 1 has a recess to receive the house 63 and a number of pull rods 72 for clamping the cover to the frame without passing through the house.

8. Claims 1, 2, 4, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/06725 to Heinlein et al.

Re-claim 1, Heinlein et al. discloses a modular disc brake, comprising : a service brake mechanism 57 and modules in the form of a frame 5, a house 7 for the service brake mechanism and a cover (interpreted as the pneumatic actuator connected to the rear side of the house, the actuator covers the end of the house), the frame 1 has a recess to receive the house (see figure 1).

Re-claim 2, a lower part of the house is received in the recess.

Re-claim 4, the brake mechanism is a single pre-mounted unit received in the house.

Re-claim 11, the house receives a lever 81 of the brake mechanism.

Re-claim 13, Heinlein et al. discloses a modular disc brake, comprising: a brake mechanism 57 and modules in the form of a frame 5, a house 7, a cover (interpreted as the pneumatic actuator connected to the rear side of the house, the actuator covers the end of the

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house), the frame 1 has a recess to receive the house (see figure 1), wherein the house encloses the brake mechanism and a lever 81.

9. Claims 1, 2, 4, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/45292 to Rieth et al. US 6,405,836 is the English language equivalent.

Re-claim 1, Rieth et al. discloses a modular disc brake, comprising: a service brake mechanism 15 and modules in the form of a frame 19 (column 5 lines 40-42 stated that element 19 can be formed as part of the brake caliper), a house 12 for the service brake mechanism and a cover, the frame 1 has a recess to receive the house (see figure 1).

Re-claim 2, the house does not take up any load during braking, since it is compressed between the frame and the cover.

Re-claim 4, the brake mechanism is a single pre-mounted unit received in the house.

Re-claim 11, the house receives a lever 38 of the brake mechanism.

Re-claim 13, Rieth et al. discloses a modular disc brake, comprising: a brake mechanism 15 and modules in the form of a frame 19, a house 12, a cover, the frame 19 has a recess to receive the house (see figure 1), wherein the house encloses the brake mechanism and a lever 38.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rieth et al.

Re-claim 3, Rieth et al. fails to specifically teach the house being made from a plastic. The use of plastic in place of metal is known in the art as a way of reducing costs and weight. It would have been obvious to one of ordinary skill in the art to have manufactured the house of Rieth et al. from a plastic material, thus reducing manufacturing costs as well as weight.

Re-claims 5-7, the brake is pre-mounted in the house, the cover is attached to cover the end of the house, the house is open in one direction to receive the brake mechanism, the house has an opening for connection with a brake mechanism and thrust plate, a lever 38 is positioned within the house.

Allowable Subject Matter

13. Claims 8-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thomas et al., Heinlen et al., Kapaan et al., and De Vries et al. each disclose a modular disc brake.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is (703) 305-1346. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder, can be reached at (703) 308-3421. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

TJW

October 14, 2004

THOMAS WILLIAMS
PATENT EXAMINER

Thomas Williams

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10-15-04